



#A.F/2859
IFW

Attorney Docket No.: 225/49355
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

AXEL SCHAMAL

Group Art Unit: 2859

Serial No.: 09/674,852

Examiner: T. Reis

Filed: December 14, 2000

For: DEVICE FOR DETERMINING THE POSITION OR SIZE OF A HOLE

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Real Party in Interest

The real party in interest is DaimlerChrysler AG, Epplestrasse 225, 70567 Stuttgart, Germany, by virtue of an assignment recorded in the U.S. Patent and Trademark Office assignment records at reel 011385, frame 0165.

Related Appeals and Interferences

No interferences or other appeals which would affect, be affected by, or have a bearing on a decision in this appeal are known.

07/14/2004 HALI11 00000056 09674852

01 FC:1402

330.00 OP

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Status of Claims

Claims 1, 3-6, and 8-10 are pending in this application, are rejected, and are now appealed. Claims 2 and 7 were cancelled by way of the reply filed October 16, 2002. An appendix containing a copy of claims 1, 3-6, and 8-10 is attached to this Appeal Brief.

Status of Amendments

No amendment has been filed subsequent to the final rejection set forth in the Office Action dated February 10, 2004.

Summary of Invention

A concise explanation of the invention will now be provided. This explanation refers, by way of example only and without intending to limit the claims, to certain drawing figures and to page and line numbers of the substitute specification filed November 7, 2000.

A device for determining the position of or for measuring a hole in a body part of a motor vehicle (see, for example, page 2, lines 13-16) includes a spike 1 for fitting into the hole (see, for example, page 4, lines 30-32) and an attachment element 2 having an essentially hemispherical or partially spherical shell 3 and an insert 4 arranged within the shell (see, for example, page 4, lines 7-12 and 38-40, and Figures 2-3). By way of a screw thread 1a (see, for example, page 4, lines 7-8), the attachment element 2 is releasably connectable to the spike 1 and, with the spike

fitted into the hole, rests on the component surface surrounding the hole (see, for example, Figure 3).

As discussed, for example, in lines 20-26 on page 4, the shell 3 may be made of a non-magnetic material, and the insert 4 arranged within the shell may be made of magnetic material. Referring to Figures 2 and 3, as noted in lines 14-16 on page 4, a lower edge 3a of the shell bears substantially flush against a lower side 4a of the insert when the device is assembled. According to certain configurations of the device, the spike 1 can be fastened to the attachment element 2 in an asymmetrical manner with respect thereto (see, for example, page 3, lines 21-24).

Issues

The following issues are presented for review.

1. Whether claims 1, 3, 4, and 6 are unpatentable over U.S. Patent 2,419,134 to Hall in view of U.S. Patent 4,680,869 to Murkens.
2. Whether claims 5 and 8-10 are unpatentable over the Hall and Murkens patents in view of U.S. Patent 4,220,187 to Holmes.

Grouping of Claims

With respect to issue 1 above, claims 1, 3, 4, and 6 stand or fall together.

With respect to issue 2 above, claims 5 and 8-10 stand or fall together.

Argument

I. The rejection of claims 1, 3, 4, and 6 as being unpatentable over the Hall and Murkens patents is erroneous.

In section 2 on pages 2-3 of the Office Action, the Examiner proposes to “add” the magnetic second hollow cylindrical member 32 disclosed by Murkens to the ball like portion 1 forming part of the Hall locator, in part because the ball like portion 1 “can stably locate holes in vertical surfaces”. The Hall patent, however, already discloses various ways in which the ball like portion may be stably located or clamped solidly in place. Lines 16-19 in column 2 of the Hall patent, for example, provide that there is a recess 6 by which the device may be held by a clamp. The Hall patent further contemplates using a threaded element (see column 2, lines 21-24), a screw and washer (see column 3, lines 68-70 and column 4, lines 6-10), and a strap (see column 4, lines 11-21) to secure the ball like portion in place. The addition proposed by the Examiner, therefore, duplicates an already existing function and is unnecessary.

The Examiner’s proposal to arbitrarily add the second hollow cylindrical member 32 of the Murkens permanent magnet assembly 33 to the ball like portion 1 of the Hall locator is inappropriate. Lines 32-40 in column 2 of the Murkens patent provide that the Murkens permanent magnet assembly 33 includes a first hollow cylindrical member 31 and a permanent central magnet 34 as well as the second hollow cylindrical member 32 referred to by the Examiner. Nothing properly relied on by the Examiner suggests separating member 32 from member 31 and magnet

34 and adding only that member 32, in the manner proposed, to the ball like portion 1 of the Hall locator.

The proposed addition of the magnetic second hollow cylindrical member 32 disclosed by Murkens is further justified by the Examiner because “the stably locating means claimed by Applicant and the stably locating means used by Hall & Murkens are well known alternate types of stably locating means” As noted in MPEP §2144.03(A), however, official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well known are capable of instant and unquestionable demonstration. No claim of the present application recites “stably locating means,” and it is unclear which elements of either the claimed invention or the Hall locator, as the Examiner proposes to modify it, the Examiner considers to be the “stably locating means” referred to in the rejection. It certainly is questionable, therefore, as to whether any “stably locating means” of the present invention is a well known alternate to any other “stably locating means” as the Examiner asserts, and the official notice taken by the Examiner is improper.

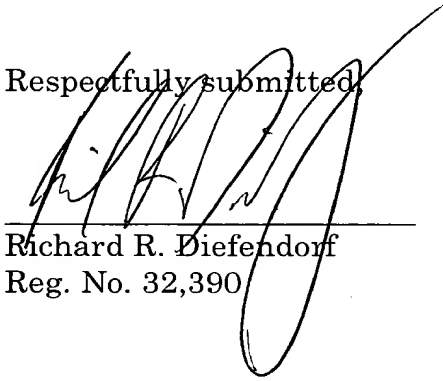
The modification to the locator forming the subject matter of the Hall patent proposed by the Examiner in section 2 on pages 2-3 of the Office Action is inappropriate for reasons discussed above, and the Hall and Murkens patents, taken as a whole, do not suggest the subject matter of any of claims 1, 3, 4, and 6. The rejection of these claims, which relies on the modification proposed by the Examiner, is erroneous and should be reversed.

II. The rejection of claims 5 and 8-10 as being unpatentable over the Hall, Murkens, and Holmes patents is also erroneous. This rejection relies on the same proposed modification to the Hall locator discussed in section I above and should be reversed for the same reasons.

Date: July 9, 2004

CROWELL & MORING LLP
P.O. Box 14300
Washington, D.C. 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
RRD:msy

Respectfully submitted,



Richard R. Diefendorf
Reg. No. 32,390



Appendix

1. Device for determining the position of or for measuring a hole in a body part of a motor vehicle, comprising:

a spike for fitting into the hole, and

an attachment element which is releasably connectable to the spike and, with the spike fitted into the hole, rests on the component surface surrounding the hole,

wherein the attachment element has an essentially hemispherical or partially spherical shell made of a non-magnetic material and an insert arranged within the shell and made of magnetic material, and

wherein a lower edge of the shell bears substantially flush against a lower side of the insert.

3. Device according to Claim 1, wherein the attachment element is releasably connectable to the spike by a screw thread.

4. Device according to Claim 3, wherein the spike has an upper part with the screw thread which is adapted to pass through the insert and be screwed to the inside of the shell.

5. Device for determining the position of or for measuring a hole in a component comprising:

a spike for fitting into the hole, and

an attachment element which is releasably connectable to the spike and, with the spike fitted into the hole, rests on the component surface surrounding the hole, wherein at least part of the attachment element is produced from a magnetic material, and wherein the spike is adapted to be fastened to the attachment element in an asymmetrical manner with respect thereto.

6. Attachment element for a device for determining the position of or for measuring a hole which is releasably connectable to a spike which is adapted to fit into the hole, at least part of the attachment element being produced from a magnetic material, comprising an essentially hemispherical or partially spherical shell made of a non-magnetic material and an insert arranged within the shell and made of a magnetic material, wherein a lower edge of the shell bears substantially flush against a lower side of the insert.

8. Device for determining the position of or for measuring a hole in a component comprising:

a spike for fitting into the hole, and

an attachment element which is releasably connectable to the spike and, with the spike fitted into the hole, rests on the component surface surrounding the hole,

wherein the attachment element has an essentially hemispherical or partially spherical shell made of a non-magnetic material and an insert arranged within the shell and made of magnetic material, and

wherein the spike is adapted to be fastened to the attachment element in an asymmetrical manner with respect thereto.

9. Device for determining the position of or for measuring a hole in a component comprising:

a spike for fitting into the hole, and

an attachment element which is releasably connectable to the spike and, with the spike fitted into the hole, rests on the component surface surrounding the hole,

wherein the attachment element has an essentially hemispherical or partially spherical shell made of a non-magnetic material and an insert arranged within the shell and made of magnetic material,

wherein the attachment element is releasably connectable to the spike by a screw thread, and

wherein the spike is adapted to be fastened to the attachment element in an asymmetrical manner with respect thereto.

10. Device for determining the position of or for measuring a hole in a component comprising:

a spike for fitting into the hole, and

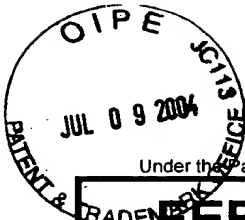
an attachment element which is releasably connectable to the spike and, with the spike fitted into the hole, rests on the component surface surrounding the hole,

wherein the attachment element has an essentially hemispherical or partially spherical shell made of a non-magnetic material and an insert arranged within the shell and made of magnetic material,

wherein the attachment element is releasably connectable to the spike by a screw thread,

wherein the spike has an upper part with the screw thread which is adapted to pass through the insert and be screwed to the inside of the shell, and

wherein the spike is adapted to be fastened to the attachment element in an asymmetrical manner with respect thereto.



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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)**330**

Complete if Known

Application Number	09/674,852
Filing Date	December 14, 2000
Inventor	Axel SCHAMAL
Examiner Name	T. Reis
Art Unit	2859
Attorney Docket No.	225/49355

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number	05-1323
Deposit Account Name	Crowell & Moring LLP

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Charge any deficiency or credit any overpayments to the deposit account of the undersigned. Attorney Docket No. 038738.49355

☐ Charge any additional fee(s) during the pendency of this application.

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Entity Fee Code	Small Entity Fee Code	Fee Description	Fee Paid
1001	770	2001	385 Utility filing fee	
1002	340	2002	170 Design filing fee	
1003	530	2003	265 Plant filing fee	
1004	770	2004	385 Reissue filing fee	
1005	160	2005	80 Provisional filing fee	

SUBTOTAL (1)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20** =	x	=
Indep. Claims	-3** =	x	=
Multiple Dependent			=

Large Entity Fee Code	Small Entity Fee Code	Fee Description
1202	18	2202 9 Claims in excess of 20
1201	86	2201 43 Independent claims in excess of 3
1203	290	2203 145 Multiple dependent claim, if not paid
1204	86	2204 43 ** Reissue independent claims over original patent
1205	18	2205 9 ** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) \$

**or number previously paid, if greater; For Reissues, see above.

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Small Entity Fee Code	Fee Description
1051	130	2051 65 Surcharge - late filing fee or oath
1052	50	2052 25 Surcharge - late provisional filing fee or cover sheet
1053	130	1053 130 Non-English specification
1812	2,520	1812 2,520 For filing a request for <i>ex parte</i> reexamination
1804	920*	1804 920* Requesting publication of SIR prior to Examination action
1805	1,840*	1805 1,840* Requesting publication of SIR after Examiner action
1251	110	2251 55 Extension for reply within first month
1252	420	2252 210 Extension for reply within second month
1253	950	2253 475 Extension for reply within third month
1254	1,480	2254 740 Extension for reply within fourth month
1255	2,010	2255 1,005 Extension for reply within fifth month
1401	330	2401 165 Notice of Appeal
1402	330	2402 165 Filing a brief in support of an appeal
1403	290	2403 145 Request for oral hearing
1451	1,510	1451 1,510 Petition to institute a public use proceeding
1452	110	2452 55 Petition to revive - unavoidable
1453	1,330	2453 665 Petition to revive - unintentional
1501	1,330	2501 665 Utility issue fee (or reissue)
1502	480	2502 240 Design issue fee
1503	640	2503 320 Plant issue fee
1406	130	1460 130 Petitions to the Commissioner
1807	50	1807 50 Processing fee under 37 CFR 1.17(q)
1806	180	1806 180 Submission of Information Disclosure Stmt
8021	40	8021 40 Recording each patent assignment per property (times number of properties)
1809	770	2809 385 Filing a submission after final rejection (37 CFR § 1.129(a))
1810	770	2810 385 For each additional invention to be examined (37 CFR § 1.129(b))
1801	770	2801 385 Request for Continued Examination (RCE)
1802	900	1802 900 Request for expedited examination of a design application

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

330

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Richard R. Diefendorf	Registration No. (Attorney/Agent)	32,390	Telephone	202-624-2500
Signature				Date	July 9, 2004

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